

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Gupta**

Serial No. 09/881,872

Filed: June 14, 2001

For: **Apparatus and Method for  
Selecting Closing Information and  
Stationery for an Electronic Mail  
Message Based on the Intended  
Recipient**

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Group Art Unit: 2152

Examiner: Refai, Ramsey

**Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450**

**35525**  
PATENT TRADEMARK OFFICE  
CUSTOMER NUMBER

**APPEAL BRIEF (37 C.F.R. 41.37)**

This brief is in furtherance of the Notice of Reinstatement of Appeal, filed in this case on June 8, 2006.

No fees are believed to be required. If, however, any fees are required, I authorize the Commissioner to charge these fees which may be required to IBM Corporation Deposit Account No. 09-0447. No extension of time is believed to be necessary. If, however, an extension of time is required, the extension is requested, and I authorize the Commissioner to charge any fees for this extension to IBM Corporation Deposit Account No. 09-0447.

**REAL PARTY IN INTEREST**

The real party in interest in this appeal is the following party: International Business Machines Corporation of Armonk, New York.

### **RELATED APPEALS AND INTERFERENCES**

With respect to other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in the pending appeal, there are no such appeals or interferences.

## **STATUS OF CLAIMS**

### **A. TOTAL NUMBER OF CLAIMS IN APPLICATION**

Claims in the application are: 1-41

### **B. STATUS OF ALL THE CLAIMS IN APPLICATION**

1. Claims canceled: NONE
2. Claims withdrawn from consideration but not canceled: NONE
3. Claims pending: 1-41
4. Claims allowed: NONE
5. Claims rejected: 1-41
6. Claims objected to: NONE

### **C. CLAIMS ON APPEAL**

The claims on appeal are: 1-41

### **STATUS OF AMENDMENTS**

There are no amendments after final rejection.

## **SUMMARY OF CLAIMED SUBJECT MATTER**

### **A.1. CLAIM 1 - INDEPENDENT**

The presently claimed invention provides a method for formatting an electronic mail message. The present invention retrieves one or more recipient profiles from storage. Each recipient profile identifies an electronic mail message format for a corresponding recipient. (See specification, page 12, line 1, to page 13, line 28; page 14, lines 9-31; page 15 lines 20-32; page 18, lines 13-29; page 22, lines 8-16). The present invention identifies a recipient of an electronic mail message and formats content of the electronic mail message based on a recipient profile corresponding to the identified recipient. (See specification, page 11, lines 11-31; page 13, line 29, to page 14, line 8; page 15, lines 1-19; page 16, line 1, to page 17, line 6; page 18, lines 4-29; page 22, line 3, to page 23, line 18).

### **A.1. CLAIM 11 - INDEPENDENT**

The presently claimed invention provides a method for customizing an electronic mail message based on settings for a recipient. The present invention receives an electronic mail message. (See specification, page 12, lines 23-27; page 13, line 29, to page 14, line 8; page 18, lines 15-22). The present invention retrieves one or more recipient profiles from storage. Each recipient profile identifies an electronic mail message format for a corresponding recipient. (See specification, page 12, line 1, to page 13, line 28; page 14, lines 9-31; page 15 lines 20-32; page 18, lines 13-29; page 22, lines 8-16). The present invention identifies at least one recipient of an electronic mail message. The present invention identifies at least one electronic mail message format from the one or more profiles for the at least one recipient. The present invention then reformats content of the electronic mail message based on the at least one electronic mail message format. (See specification, page 11, lines 11-31; page 13, line 29, to page 14, line 8; page 15, lines 1-19; page 16, line 1, to page 17, line 6; page 18, lines 4-29; page 22, line 3, to page 23, line 18).

#### **A.1. CLAIM 22 - INDEPENDENT**

The presently claimed invention provides an apparatus for customizing an electronic mail message based on settings for a recipient. The present invention comprises an interface **420** that receives an electronic mail message. (See specification, page 12, lines 23-27; page 13, line 29, to page 14, line 8; page 18, lines 15-22). The present invention comprises an electronic mail message formatting device **450** that retrieves one or more recipient profiles from storage. Each recipient profile identifies an electronic mail message format for a corresponding recipient. (See specification, page 12, line 1, to page 13, line 28; page 14, lines 9-31; page 15 lines 20-32; page 18, lines 13-29; page 22, lines 8-16). The electronic mail message formatting device **450** identifies at least one recipient of an electronic mail message. The present invention identifies at least one electronic mail message format from the one or more profiles for the at least one recipient. The present invention then reformats content of the electronic mail message based on the at least one electronic mail message format. (See specification, page 11, lines 11-31; page 13, line 29, to page 14, line 8; page 15, lines 1-19; page 16, line 1, to page 17, line 6; page 18, lines 4-29; page 22, line 3, to page 23, line 18).

#### **A.1. CLAIM 32 - INDEPENDENT**

The presently claimed invention provides a computer program product for customizing an electronic mail message based on settings for a recipient. The present invention provides for instructions for receiving an electronic mail message. (See specification, page 12, lines 23-27; page 13, line 29, to page 14, line 8; page 18, lines 15-22). The present invention provides for instructions for retrieving one or more recipient profiles from storage. Each recipient profile identifies an electronic mail message format for a corresponding recipient. (See specification, page 12, line 1, to page 13, line 28; page 14, lines 9-31; page 15 lines 20-32; page 18, lines 13-29; page 22, lines 8-16). The present invention provides for instructions for identifying at least one recipient of an electronic mail message. The present invention provides for instructions for identifying at least one electronic mail message format from the one or more profiles for the at least one recipient. The present invention provides for instructions for then reformatting content

of the electronic mail message based on the at least one electronic mail message format. (See specification, page 11, lines 11-31; page 13, line 29, to page 14, line 8; page 15, lines 1-19; page 16, line 1, to page 17, line 6; page 18, lines 4-29; page 22, line 3, to page 23, line 18). The computer instructions embodied on a computer readable medium are as described with reference to **Figure 10** in the description at page 22, line 3, to page 23, line 31.

#### **A.1.(a) CLAIM 4 - DEPENDENT**

The presently claimed invention provides a method of claim 1, wherein the electronic mail message is directed to a plurality of designated recipients, and wherein formatting content of the electronic mail message includes identifying a set of compatible electronic mail format settings from among the electronic mail format settings of the designated recipients. (See specification, page 12, lines 16-30; page 12 line 31 – page 13 line 28; page 14 line 5 - page 16, line 27; Figure 6, 620 and 630 and c 720 and 730).

#### **A.1.(a) CLAIM 14 - DEPENDENT**

The presently claimed invention provides a method of claim 11, wherein the electronic mail message is directed to a plurality of recipients, and wherein reformatting content of the electronic mail message includes identifying a set of compatible electronic mail message format settings from among the electronic mail message format settings of the plurality of recipients. (See specification, page 12, lines 16-30; page 12 line 31 – page 13 line 28; page 14 line 5 - page 16, line 27; Figure 6, 620 and 630 and c 720 and 730).

#### **A.1.(a) CLAIM 25 - DEPENDENT**

The presently claimed invention provides an apparatus of claim 22, wherein the electronic mail message is directed to a plurality of recipients, and wherein the electronic mail message formatting device reformats content of the electronic mail message by identifying a set of compatible electronic mail message format settings from among the electronic mail message



format settings of the plurality of recipients. (See specification, page 12, lines 16-30; page 12 line 31 – page 13 line 28; page 14 line 5 - page 16, line 27; Figure 6, 620 and 630 and c 720 and 730).

#### **A.1.(a) CLAIM 35 - DEPENDENT**

The presently claimed invention provides a computer program product of claim 32, wherein the electronic mail message is directed to a plurality of recipients, and wherein the fifth instructions for reformatting content of the electronic mail message include instructions for identifying a set of compatible electronic mail message format settings from among the electronic mail message format settings of the plurality of recipients. (See specification, page 12, lines 16-30; page 12 line 31 – page 13 line 28; page 14 line 5 - page 16, line 27; Figure 6, 620 and 630 and c 720 and 730). The computer instructions embodied on a computer readable medium are as described with reference to **Figure 10** in the description at page 22, line 3, to page 23, line 31.

#### **A.1.(b) CLAIM 6 - DEPENDENT**

The presently claimed invention provides a method of claim 4, wherein the electronic mail format settings include at least one of closing information, stationery, or whether to use spell check. (See specification, page 12, lines 3-10, and 16-21; page 13, lines 1-2 and 13-17; **Figure 6, 630, Figure 7, 730**).

#### **A.1.(b) CLAIM 16 - DEPENDENT**

The presently claimed invention provides a method of claim 11, wherein the electronic mail message format settings include at least one of closing information, stationery, or whether to use spell check. (See specification, page 12, lines 3-10, and 16-21; page 13, lines 1-2 and 13-17; **Figure 6, 630, Figure 7, 730**).

#### **A.1.(b) CLAIM 27 - DEPENDENT**

The presently claimed invention provides an apparatus of claim 22, wherein the electronic mail message format settings include at least one of closing information, stationery, or whether to use spell check. (See specification, page 12, lines 3-10, and 16-21; page 13, lines 1-2 and 13-17; **Figure 6, 630, Figure 7, 730**).

#### **A.1.(b) CLAIM 37 - DEPENDENT**

The presently claimed invention provides a computer program product of claim 32, wherein the electronic mail message format settings include at least one of closing information, stationery, or whether to use spell check. (See specification, page 12, lines 3-10, and 16-21; page 13, lines 1-2 and 13-17; **Figure 6, 630, Figure 7, 730**). The computer instructions embodied on a computer readable medium are as described with reference to **Figure 10** in the description at page 22, line 3, to page 23, line 31.

#### **A.2. CLAIM 21 - INDEPENDENT**

The presently claimed invention provides a method for customizing an electronic mail message based on settings for an intended recipient. The present invention stores electronic mail format settings in recipient profiles for a plurality of possible recipients. The electronic mail format settings designate an electronic mail format for a recipient that is different from an electronic mail format of another recipient. See specification, page 12, line 1, to page 13, line 28; page 14, lines 9-31; page 15 lines 20-32; page 18, lines 13-29; page 22, lines 8-16. An electronic mail message is generated for at least one designated recipient of the plurality of possible recipients. See specification, page 12, lines 23-27; page 13, line 29, to page 14, line 8; page 18, lines 15-22. The present invention customizes content of the electronic mail message according to the electronic mail format settings for the recipient. See specification, page 11, lines 11-31; page 13, line 29, to page 14, line 8; page 15, lines 1-19; page 16, line 1, to page 17, line 6; page 18, lines 4-29; page 22, line 3, to page 23, line 18.

## **GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

### **A. GROUND OF REJECTION 1**

Claims 1, 4-9, 11, 16-19, 21-22, 25-30, 32, and 35-40 under 35 U.S.C. § 103(a) as being allegedly obvious over *Gilbert* (U.S. Patent No. 6,529,942) in view of *Pedersen* (U.S. Patent No. 6,965,920).

### **B. GROUND OF REJECTION 2**

Claims 2, 3, 10, 12-15, 20, 23, 24, 31, 33, 34, and 41 are rejected under 35 U.S.C. § 103(a) as being allegedly obvious over *Gilbert* (U.S. Patent No. 6,529,942) in view of *Pedersen* (U.S. Patent No. 6,965,920) and further in view of *Schuetze et al.* (U.S. Patent No. 6,101,320).

## ARGUMENT

**A. 35 U.S.C. § 103, Alleged Obviousness of claims 1, 4-9, 11, 16-19, 21, 22, 25-30, 32, and 35-40**

The Final Office Action rejects claims 1, 4-9, 11, 16-19, 21-22, 25-30, 32, and 35-40 under 35 U.S.C. § 103(a) as being unpatentable over *Gilbert*, System and Method for Providing Recipient Specific Formats for Electronic Mail, U.S. Patent No. 6,529,942, March 4, 2003 (hereinafter “*Gilbert*”) in view of *Pedersen*, Profile Responsive Electronic Message Management System, U.S. Patent No. 6,965,920, November 15, 2005 (hereinafter “*Pedersen*”). This rejection is respectfully traversed.

**A.1. 35 U.S.C. § 103, Alleged Obviousness of claims 1, 4-9, 11, 16-19, 22, 25-30, 32, and 35-40**

With regard to claim 1, the Final Office Action states:

5. As per claim 1, Gilbert teaches a method of formatting an electronic mail message, comprising:

identifying a recipient of an electronic mail message (**column 3, lines 3 - 5**); and

formatting content of the electronic mail message based on a recipient profile from the one or more recipient profiles corresponding to the identified recipient (**column 5, lines 49-63, column 7, lines 47-55, column 9, lines 6-11, column 3, lines 3 - 22**).

6. Gilbert fails to teach retrieving one or more recipient profiles from storage wherein each recipient profile within the one or more recipient profiles identifies an electronic mail message format for a corresponding recipient.

7. However, Pedersen teaches an individual message generator that obtains information from recipient profiles stored in a database and generates individual messages for each recipient based on that information (**abstract, column 2, lines 26-67, column 3, lines 48-65**). It would have been obvious to one of the ordinary skill in the art at the time of the Applicant's invention to combine the teachings of Gilbert and Pedersen because doing so would provide a message management server that customizes electronic mail messages by referring to stored user-defined recipient profiles. The use of stored user-defined recipient profiles ensures that all

messages addressed to that particular recipient are customized in the same way and allows for a recipient to easily change/update their profile to meet that recipient's preference.

Final Office Action, dated March 3, 2006, pages 3-4.

A fundamental notion of patent law is the concept that invention lies in the new combination of old elements. Consequently, a rule exists that a combination of references made to establish a *prima facie* case of obviousness must be supported by some teaching, suggestion, or incentive contained in the prior art which would have led one of ordinary skill in the art to make the claimed invention. The Examiner bears the burden of establishing a *prima facie* case of obviousness based on the prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992).

*Gilbert* teaches a system and method for providing recipient specific formats for electronic mail. A composer of an email message may customize the format of text within the email message by embedding codes within the message. The relevant cited portions of *Gilbert* state:

The present invention is embodied in a functional component that recognizes embedded processing codes for a specific recipient in an e-mail system. This functional component can be integrated into e-mail software or can exist separate from the electronic mail software. Upon recognition of an embedded text format command, the functional component changes the font characteristics of selected text for specific recipients based upon an identifier code identifying each recipient's message. Individualized copies of the original message are automatically created for each recipient. The invention thus allows a single message to be modified for more than one recipient such that individual modifications corresponding to a particular recipient are received only by that recipient. A computerized network serving as an environment for the present invention is first described. Next, the processing steps required to format text for a specific recipient are described along with the processing steps necessary for automatically creating e-mail messages. Examples of e-mail messages with embedded processing codes are also presented.

*Gilbert*, col. 3, lines 3-22.

Thus, *Gilbert* teaches that when a composer of an electronic mail message wishes to customize the format for an email message, the composer must deliberately embed specific commands within the message for each intended recipient. Customized format is only effectuated through these embedded commands.

In contradistinction, the present invention allows customization of an electronic mail message based on one or more recipient profiles. Claim 1 recites:

1. A computer implemented method of formatting an electronic mail message, comprising:
  - retrieving one or more recipient profiles from storage, wherein each recipient profile within the one or more recipient profiles identifies an electronic mail message format for a corresponding recipient;
  - identifying a recipient of an electronic mail message; and
  - formatting content of the electronic mail message based on a recipient profile from the one or more recipient profiles corresponding to the identified recipient.

*Gilbert* does not teach or suggest formatting content of the electronic mail message based on a recipient profile from the one or more recipient profiles corresponding to the identified recipient, as recited in claim 1, for example. The Final Office Action alleges that *Gilbert* teaches this feature at col. 5, lines 49-63; col. 7, lines 27-55; col. 9, lines 6-11; and col. 3, lines 3-22, alleging that the mail server of *Gilbert* reformats the content of the message by referring to profiles stored on the mail server that matches the recipient's user name to the identifier code, which represents the format specific to that corresponding user.

The cited portions of *Gilbert* teach as follows:

In one embodiment, the software is installed in the originating user's data processing system **20** which analyzes or parses the message and generates a separate, properly formatted e-mail message for each recipient. In another embodiment, a computer coupled to the network **10** as a mail server **11** contains the software which processes the original e-mail message having the embedded processing codes. The mail server **11** analyzes both the text format commands and the identifier codes embedded in the message and generates a separate, properly formatted e-mail message for each recipient. In the two embodiments just described, the e-mail message received by a recipient is properly formatted and does not contain any formatting codes.

*Gilbert*, col. 5, lines 49-63.

The above described embodiment of automatically creating individualized e-mail messages is performed by having the, software installed in the originating user's data processing system **20** or in a computer coupled to the network **10** such as a mail server **11**. Since the e-mail message received by a recipient is properly formatted and does not contain any visible formatting codes, the steps outlined in FIG. **4A** are done transparent to the recipient. Therefore, the embodiment illustrated in FIG. **4A** is transparent to the e-mail program operating at a recipient's data processing system **20**.

Another embodiment of the subroutine steps necessary for automatically creating individualized e-mail messages is to have the software installed in the recipient's data processing system **20** or in a computer coupled to the network **10** such as a mail server **11**. In either case, the software processes the identifier codes embedded in the message for correlating an identifier code to the recipient. FIG. **4B** is a flow chart of one embodiment of the subroutine steps required for automatically creating an individualized e-mail message. In step **90**, the recipient receives a message having embedded processing codes. Next, the software determines if the recipient has been assigned an identifier code (step **94**).

If the recipient has not been assigned an identifier code, then the embedded processing codes are ignored. If an identifier code has been assigned, then the software correlates the embedded text format commands to the recipient's identifier code. To determine if an identifier code has been assigned, the software matches the recipient's user name with the embedded processing codes to find a match. If a match is found, the number or letter used as an identifier code is recognized by the recipient's software.

*Gilbert*, col. 7, lines 25-55.

One embodiment is to have the originating user's software analyze or parse the message and generate separate, properly formatted e-mail messages for each recipient. Another embodiment is to have a mail server **11** or an equivalent network device process the e-mail message when sending the message to the correct recipients. A third embodiment of processing inserted format commands and automatically creating individualized messages involves performing these tasks on the recipient's data processing machine **20**. In this embodiment, each recipient receives all the inserted format commands that were encoded but their data processing system **20** only decodes the inserted format commands relevant to them.

*Gilbert*, col. 9, lines 6-17.

Clearly, the cited portions do not teach formatting content of the electronic mail message based on a recipient profile, because *Gilbert* specifically teaches parsing electronic mail messages to find **embedded** processing codes or **inserted** format commands. The passage in column 7, lines 25 through 55 of *Gilbert* teaches the use of an "identifier code" to identify an individual recipient. However, in lines 15 through 18 of column 7, *Gilbert* teaches that the identifier code is also code that has to be embedded in the e-mail message: "the software correlates the embedded identifier codes to a specific recipient for determining which recipients are to receive the text format codes." In fact, the word "profile" does not appear anywhere within the *Gilbert* disclosure.

*Gilbert* appears to solve a similar problem as the present invention; however, *Gilbert* solves the problem in a very different manner. That is, *Gilbert* solves the problem of customizing the content of email messages by embedding recipient-specific formatting commands within the document itself. *Gilbert* does not teach or suggest retrieving one or more recipient profiles and formatting content of the electronic message based on settings contained in a recipient profile corresponding to the intended recipient, as recited in claim 1, for example.

Furthermore, *Pedersen* does not cure the deficiencies of *Gilbert*. *Pedersen* does not teach the feature missing from *Gilbert* including “formatting content of the electronic mail message based on a recipient profile from the one or more recipient profiles corresponding to the identified recipient.” The Final Office Action does not point to any passage of *Pedersen* as teaching this feature, nor does any passage of *Pedersen* teach this feature. The Examiner does, however, point to *Pedersen* as allegedly teaching the feature of “retrieving one or more recipient profiles from storage, wherein each recipient profile within the one or more recipient profiles identifies an electronic mail message format for a corresponding recipient.” However, *Pedersen* does not teach this feature.

*Pedersen* teaches an individual message generator that obtains rules about how to distribute specific types of messages and content from specific messengers to individual recipients from recipient profiles stored in a database and generates individual messages for each recipient based on the rules contained in the recipient profile (See, *Pedersen*, abstract). In paragraph [0042], *Pedersen* explains what a recipient profile is comprised of:

A recipient will log on to the message management system server **1000** and enter his/her basic identification data. The identification data will be stored in the recipient ID and profile database **121**, a sub system of the profile database **56** of FIG. 2. In addition, the recipient will enter one or more sets of message profile data, specifying one or more messengers, type of messages and type of content the recipient wishes to receive from each messenger. These data will be stored in the recipient message profile database **122**, a sub system of the profile database **56** in FIG. 2. For each message profile entered, the recipient will specify one or more message delivery profiles with data about how messages must be distributed, where to receive the specified message and the type of message devices to transmit the messages. These data are stored in the message delivery profile database **123**, a subsystem of the profile database **56** in FIG. 2.



The above cited passage, paragraph [0042], of *Pedersen* teaches that the recipient profile contains information about whom the recipient wishes to receive messages from, how the messages must be delivered, where to receive the specified messages, and the type of message device to transmit the messages. Nowhere does this passage of *Pedersen* teach that a recipient profile contains settings for content of the electronic mail message.

Furthermore, in paragraph [0048], *Pedersen* teaches that a recipient profile contains basic profile parameters, such as country, city, and gender. The recipient profile contains a list of messengers that the recipient desires to receive content from, the message type, and content type to be received from each messenger. The recipient profile also specifies preferred delivery profiles. A delivery profile is where to deliver the message to, such as to a “message device, the delivery address, the delivery schedule, sequence of appearance, etc. for each message and content type specified in step 106” (*Pedersen*, paragraph [0048]). Nowhere does this passage or any other passage of *Pedersen* teach formatting the content contained in the message to be delivered to the recipient, nor does any portion of *Pedersen* teach formatting the content of an electronic mail message based on settings contained in a recipient profile. *Pedersen* does not teach a recipient profile that contains electronic mail message format settings that correspond to the formatting of the content. At best, *Pedersen* teaches delivering a message through various delivery formats, such as by “electronic mail, voice telephone, facsimile transmission, and digital transmission, or other means ...” (*Pedersen*, paragraph [0013]).

Therefore, for all the reasons set forth above, Appellant submits that neither *Gilbert*, nor *Pedersen*, nor the combination of *Gilbert* in view of *Pedersen* teaches or suggests the features as recited in claim 1 of the present invention. Thus, the Examiner has failed to establish a *prima facie* case of obviousness. The applied reference does not teach or suggest each and every claim limitation; therefore, the present claimed invention is not obvious over *Gilbert* in view of *Pedersen*. Independent claims 11, 22, and 32 recite subject matter addressed above with respect to claim 1 and are allowable for similar reasons. Since claims 4-9, 16-19, 25-30, and 35-40 depend from claims 1, 11, 22, and 32, the same distinctions between the combination of *Gilbert* in view of *Pedersen*, and the invention recited in claims 1, 11, 22, and 32 apply to these claims. Additionally, claims 4-9, 16-19, 21, 25-30, and 35-40 recite other additional combinations of features not suggested by the references.

Therefore, Appellant respectfully requests that the rejection of claims 1, 4-9, 11, 16-19, 22, 25-30, 32, and 35-40 under 35 U.S.C. § 103(a) not be sustained.

Furthermore, *Gilbert* does not teach, suggest, or give any incentive to make the needed changes to reach the presently claimed invention. *Gilbert* actually teaches away from the presently claimed invention because it teaches embedding recipient-specific formatting commands into an email message, as opposed to using one or more recipient profiles that identify an electronic mail message format for a corresponding recipient, as in the presently claimed invention. Absent the Final Office Action pointing out some teaching or incentive to implement *Gilbert* to use recipient profiles to format the content of electronic mail messages, one of ordinary skill in the art would not be led to modify *Gilbert* to reach the present invention when the reference is examined as a whole. Absent some teaching, suggestion, or incentive to modify *Gilbert* in this manner, the presently claimed invention can be reached only through an improper use of hindsight using the Applicant's disclosure as a template to make the necessary changes.

**A.1.(a).      35 U.S.C. § 103, Alleged Obviousness of claims 4, 14, 25, and 35**

With respect to claims 4, 14, 25, and 35, *Gilbert* fails to teach or suggest identifying a set of compatible electronic mail format settings from among electronic mail format settings defined in recipient profiles of a plurality of designated recipients. The Final Office Action alleges that *Gilbert* teaches this limitation in col. 4, lines 16-30, which states as follows:

The present invention recognizes processing codes embedded within an e-mail message so that selected text within the message can be changed for specific recipients based upon an identifier code corresponding to each recipient's message. Furthermore, the present invention automatically creates an e-mail message corresponding to each specific recipient after the embedded processing codes have been correlated to each recipient. The functions of the present invention can be implemented within an e-mail system or can be provided as an add-on component to the e-mail system. The present invention is not limited to any particular e-mail system and one skilled in the art will recognize that the teaching of the present invention can be implemented in a variety of e-mail systems.

The cited portion of *Gilbert* merely teaches automatically creating an electronic mail message corresponding to each specific recipient after embedded processing codes have been correlated to

each recipient. The cited portion makes no mention of identifying compatible electronic mail settings from among the electronic mail format settings of a plurality of designated recipients, as recited in claims 4, 14, 25, and 35. The Final Office Action proffers no analysis as to why the cited portion somehow teaches the limitations of claims 4, 14, 25, and 35.

Therefore, Appellant respectfully requests that the rejection of claims 4, 14, 25, and 35 under 35 U.S.C. § 103(a) not be sustained.

**A.1.(b).      35 U.S.C. § 103, Alleged Obviousness of claims 6, 16, 27, and 37**

With respect to claim 6, 16, 27, and 37, *Gilbert* fails to teach or suggest wherein the electronic mail message format settings include at least one of closing information, stationery, or whether to use spell check. *Gilbert* teaches that recipient-specific formatting commands may be embedded within a message in association with particular text. Thus, these formatting commands may include text size, color, bold, italic, superscript, subscript, etc., as cited by the Examiner in *Gilbert*, col. 4, lines 64-66. However, *Gilbert* does not teach or suggest electronic mail message format settings that include closing information, stationery, or whether to use spell check, as recited in claims 6, 16, 27, and 37.

The Final Office Action alleges that *Gilbert* teaches spell checking in column 6, lines 38-67, reproduced below for the Examiner's convenience:

FIG. 3 is a flow chart of one embodiment of the subroutine steps necessary for embedding text format commands into an e-mail message. The steps illustrated in FIG. 3 correspond to step 64 in FIG. 2. After a user has generated the e-mail message (step 60 in FIG. 2), the software determines the text to be formatted as selected by the originating user within the e-mail message (step 80). In one embodiment, the originating user holds down a left mouse button on a mouse serving as a pointing device 34 and drags the screen cursor until the desired text has been highlighted or selected. One skilled in the art will realize that there are other acceptable ways of selecting text displayed on a screen.

Next, the software displays a content sensitive menu (step 82) to allow the user to select from a group of displayed functions. The content sensitive menu is displayed in response to the user clicking a right button on the mouse. Typical content sensitive menus in e-mail software programs allow the user to select from such options as "spell check", "thesaurus" or "quick help." The present invention requires modification to e-mail software for adding a "font" or "text" option similar to the "font" option available in a typical word processing program. Modifying the e-mail software to include additional options (e.g., a "text" option)

to a content menu is well known to one skilled in the art, and thus is not discussed in any further detail.

After a "text" option is displayed in step 82, the user initiates step 84 by selecting the "text" option. The software then displays a list of text format options (step 86) corresponding to the "text" option displayed via the content sensitive menu.

While *Gilbert* does nominally mention spell check as an option in a typical content-sensitive menu, *Gilbert* does not teach or suggest that whether to use spell check being defined in electronic mail format settings, as recited in claims 6, 16, 27, and 37. The Final Office Action proffers no analysis as to why conventional spell check is somehow equivalent to the specific limitation of identifying a set of compatible electronic mail format settings from among electronic mail format settings defined in recipient profiles of a plurality of designated recipients, wherein the electronic mail format settings include whether to use spell check.

Therefore, Appellant respectfully requests that the rejection of claims 6, 16, 27, and 37 under 35 U.S.C. § 103(a) not be sustained.

#### **A.2. 35 U.S.C. § 103, Alleged Obviousness of claim 21**

With reference to claim 21, the combination of *Gilbert* in view of *Pedersen* fails to teach or suggest storing electronic mail settings for content in recipient profiles for a plurality of possible recipients. Claim 21 recites:

21. A computer implemented method of customizing an electronic mail message based on settings for an intended recipient, comprising:
  - storing electronic mail format settings in recipient profiles for a plurality of possible recipients, the electronic mail format settings designating an electronic mail format for a recipient that is different from an electronic mail format of another recipient;
  - generating an electronic mail message for at least one designated recipient of the plurality of possible recipients; and
  - customizing content of the electronic mail message according to the electronic mail format settings for the recipient.

As explained above, with regards to claim 1, neither *Gilbert* nor *Pedersen*, nor the combination of *Gilbert* in view of *Pedersen*, teaches or suggests a stored recipient profile that contains electronic mail format settings regarding how to format the content of the mail message.

The applied references do not teach or suggest each and every claim limitation of claim

21; therefore, the combination of *Gilbert* in view of *Pedersen* does not render claim 21 obvious.

Therefore, Appellant respectfully requests that the rejection of claims 21 under 35 U.S.C. § 103(a) not be sustained.

**B. 35 U.S.C. § 103, Alleged Obviousness of Claims 2, 3, 10, 12-15, 20, 23-24, 31, 33-34, and 41**

The Final Office Action rejects claims 2, 3, 10, 12-15, 20, 23-24, 31, 33-34, and 41 under 35 U.S.C. § 103(a) as being unpatentable over *Gilbert* in view of *Pedersen* and further in view of *Schuetze et al.*, Electronic Mail Communication System and Method, U.S. Patent No. 6,101,320, August 8, 2000 (hereinafter “*Schuetze*”). This rejection is respectfully traversed.

**B.1. 35 U.S.C. § 103, Alleged Obviousness of Claims 2, 3, 10, 12-15, 20, 23-24, 31, 33-34, and 41**

Claims 2, 3, 10, 12-15, 20, 23-24, 31, 33-34, and 41 depend from claims 1, 11, 22, and 32 and are allowable for at least the reasons stated above with respect to claims 1, 11, 22, and 32. More particularly, the combination of *Gilbert* in view of *Pedersen* does not teach or suggest retrieving one or more recipient profiles and formatting content of the electronic message based on a recipient profile corresponding to the intended recipient. *Schuetze* does not make up for the deficiencies of the combination of *Gilbert* in view of *Pedersen*.

*Schuetze* teaches an electronic mail communication system and method for exchanging electronic mail messages between organizations having dissimilar electronic mail systems. In *Schuetze*, when an electronic mail message is received at a router, the router identifies the recipient organization and changes the transmission format of the message to match the recipient’s electronic mail system. However, *Schuetze* does not teach or suggest formatting the **content** of an electronic mail message. Rather, *Schuetze* is concerned with the transmission format expected by the recipient’s electronic mail system.

*Schuetze* does not teach the features missing from *Gilbert* in view of *Pedersen*, including the features of “retrieving one or more recipient profiles from storage, wherein each recipient profile within the one or more recipient profiles identifies an electronic mail message format for

a corresponding recipient,” and “formatting content of the electronic mail message based on a recipient profile from the one or more recipient profiles corresponding to the identified recipient.” The Examiner does not point to any passage of *Schuetze* as teaching these features, nor does any passage of *Schuetze* teach these features.

Therefore, *Gilbert* and *Pedersen* and *Schuetze*, taken individually or in combination, fail to teach or suggest the invention recited in at least claims 1, 11, 22, and 32. The proposed combination of *Gilbert* in view of *Pedersen* further in view of *Schuetze* is insufficient to render claims 1, 11, 22, and 32 obvious. It follows that the proposed combination also fails to reach dependent claims 2, 3, 10, 12-15, 20, 23-24, 31, 33-34, and 41 by virtue of their dependency.

Therefore, Appellant respectfully requests that the rejection of claims 2, 3, 10, 12-15, 20, 23-24, 31, 33-34, and 41 under 35 U.S.C. § 103(a) not be sustained.

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## **CLAIMS APPENDIX**

The text of the claims involved in the appeal are:

1. A method of formatting an electronic mail message, comprising:  
retrieving one or more recipient profiles from storage, wherein each recipient profile within the one or more recipient profiles identifies an electronic mail message format for a corresponding recipient;  
identifying a recipient of an electronic mail message; and  
formatting content of the electronic mail message based on a recipient profile from the one or more recipient profiles corresponding to the identified recipient.
2. The method of claim 1, wherein the one or more recipient profiles include a recipient group format setting corresponding to a plurality of recipients, and wherein the recipient group format setting identifies electronic mail format settings that are common to the plurality of recipients.
3. The method of claim 1, wherein the one or more recipient profiles include a domain name category format setting corresponding to a plurality of recipients, and wherein the domain name category format setting identifies electronic mail format settings that are common to the plurality of recipients.
4. The method of claim 1, wherein the electronic mail message is directed to a plurality of designated recipients, and wherein formatting content of the electronic mail message includes

identifying a set of compatible electronic mail format settings from among the electronic mail format settings of the designated recipients.

5. The method of claim 4, wherein if a set of compatible electronic mail format settings cannot be identified from among the electronic mail format settings of the designated recipients, a default set of electronic mail format settings is used to format the electronic mail message.

6. The method of claim 4, wherein the electronic mail format settings include at least one of closing information, stationery, or whether to use spell check.

7. The method of claim 1, wherein the electronic mail message is directed to a plurality of designated recipients, and wherein the electronic mail message is replicated into a different version of the electronic mail message for each of the plurality of designated recipients based on the one or more recipient profiles such that the content of each version of the electronic mail message is the same but the format of the content is specific to the electronic mail format of a corresponding recipient profile.

8. The method of claim 7, wherein the electronic mail message is replicated in response to a user entering a command to transmit the electronic mail message.

9. The method of claim 7, wherein the electronic mail message is replicated in response to a command entered by a user, and wherein the user may review the versions of the electronic mail message prior to transmitting them.



10. The method of claim 1, wherein the electronic mail message is directed to more than one designated recipient, and wherein formatting the electronic mail message includes identifying a common set of electronic mail format settings for the more than one designated recipient, and wherein identifying a common set of electronic mail format settings includes:

identifying at least one of a group set of electronic mail content format settings, a domain name category set of electronic mail content format settings, or an individual set of electronic mail content format settings for each of the at least one designated recipient;

comparing each set of electronic mail content format settings of each of the at least one designated recipient to each set of electronic mail content format settings of each other recipient of the at least one designated recipient to identify matching sets of electronic mail content format settings; and

using the matching sets of electronic mail content format settings to reformat content of the electronic mail message.

11. A method of customizing an electronic mail message based on settings for an intended recipient, comprising:

receiving an electronic mail message;

retrieving one or more recipient profiles from storage, wherein each recipient profile within the one or more recipient profiles identifies an electronic mail message format for a corresponding recipient;

identifying at least one recipient of the electronic mail message;

identifying at least one electronic mail message format from the one or more recipient profiles for the at least one recipient; and

reformatting content of the electronic mail message based on the at least one electronic mail message format.

12. The method of claim 11, wherein the at least one recipient is categorized into a recipient group, and wherein the recipient group has electronic mail format settings that are common to all of the recipients in the recipient group.

13. The method of claim 11, wherein the at least one recipient is categorized into a domain name category, and wherein the domain name category has electronic mail format settings that are common to all of the recipients in the domain name category.

14. The method of claim 11, wherein the electronic mail message is directed to a plurality of recipients, and wherein reformatting content of the electronic mail message includes identifying a set of compatible electronic mail message format settings from among the electronic mail message format settings of the plurality of recipients.

15. The method of claim 14, wherein if a set of compatible electronic mail message format settings cannot be identified from among the electronic mail message format settings of the designated recipients, a default set of electronic mail message format settings is used to reformat content of the electronic mail message.

16. The method of claim 11, wherein the electronic mail message format settings include at least one of closing information, stationery, or whether to use spell check.

17. The method of claim 11, wherein the electronic mail message is directed to a plurality of recipients, and wherein the electronic mail message is replicated into a different version of the electronic mail message for each of the plurality of recipients based on the electronic mail message format settings for each of the plurality of recipients such that the content of each version of the electronic mail message is the same but the format of the content is specific to the electronic mail message format settings of a corresponding one of the plurality of recipients.

18. The method of claim 17, wherein the electronic mail message is replicated in response to a user entering a command to transmit the electronic mail message.

19. The method of claim 17, wherein the electronic mail message is replicated in response to a command entered by a user, and wherein the user may review the versions of the electronic mail message prior to transmitting them.

20. The method of claim 11, wherein reformatting the electronic mail message includes identifying a common set of electronic mail message format settings for the at least one designated recipient, and wherein identifying a common set of electronic mail message format settings includes:

identifying at least one of a group set of electronic mail message content format settings, a domain name category set of electronic mail message content format settings, or an individual set of electronic mail message content format settings for each of the at least one recipient;

comparing each set of electronic mail message content format settings of each of the at least one recipient to each set of electronic mail message content format settings of each other recipient of the at least one recipient to identify matching sets of electronic mail message content

format settings; and

using the matching sets of electronic mail message content format settings to reformat content of the electronic mail message.

21. A method of customizing an electronic mail message based on settings for an intended recipient, comprising:

storing electronic mail format settings in recipient profiles for a plurality of possible recipients, the electronic mail format settings designating an electronic mail format for a recipient that is different from an electronic mail format of another recipient;

generating an electronic mail message for at least one designated recipient of the plurality of possible recipients; and

customizing content of the electronic mail message according to the electronic mail format settings for the recipient.

22. An apparatus for customizing an electronic mail message based on settings for an intended recipient, comprising:

an interface that receives an electronic mail message; and

an electronic mail message formatting device coupled to the interface that retrieves one or more recipient profiles from storage, wherein each recipient profile within the one or more recipient profiles identifies an electronic mail message format for a corresponding recipient, identifies at least one recipient of the electronic mail message, identifies at least one electronic mail message format from the one or more recipient profiles for the at least one recipient, and reformats content of the electronic mail message based on the at least one electronic mail message format.

23. The apparatus of claim 22, wherein the at least one recipient is categorized into a recipient group, and wherein the recipient group has electronic mail format settings that are common to all of the recipients in the recipient group.

24. The apparatus of claim 22, wherein the at least one recipient is categorized into a domain name category, and wherein the domain name category has electronic mail format settings that are common to all of the recipients in the domain name category.

25. The apparatus of claim 22, wherein the electronic mail message is directed to a plurality of recipients, and wherein the electronic mail message formatting device reformats content of the electronic mail message by identifying a set of compatible electronic mail message format settings from among the electronic mail message format settings of the plurality of recipients.

26. The apparatus of claim 25, wherein if a set of compatible electronic mail message format settings cannot be identified from among the electronic mail message format settings of the designated recipients, the electronic mail message formatting device uses a default set of electronic mail message format settings to reformat content of the electronic mail message.

27. The apparatus of claim 22, wherein the electronic mail message format settings include at least one of closing information, stationery, or whether to use spell check.

28. The apparatus of claim 22, wherein the electronic mail message is directed to a plurality of recipients, and wherein the electronic mail message formatting device replicates the electronic mail message into a different version of the electronic mail message for each of the plurality of recipients based on the electronic mail message format settings for each of the plurality of

recipients such that the content of each version of the electronic mail message is the same but the format of the content is specific to the electronic mail message format settings of a corresponding one of the plurality of recipients.

29. The apparatus of claim 28, wherein the electronic mail message is replicated in response to a user entering a command to transmit the electronic mail message.

30. The apparatus of claim 28, wherein the electronic mail message is replicated in response to a command entered by a user, and wherein the user may review the versions of the electronic mail message prior to transmitting them.

31. The apparatus of claim 22, wherein the electronic mail message formatting device reformats content of the electronic mail message by identifying a common set of electronic mail message format settings for the at least one recipient, and wherein the electronic mail message formatting device identifies a common set of electronic mail message format settings by:

identifying at least one of a group set of electronic mail message content format settings, a domain name category set of electronic mail message content format settings, or an individual set of electronic mail message content format settings for each of the at least one recipient;

comparing each set of electronic mail message content format settings of each of the at least one recipient to each set of electronic mail message content format settings of each other recipient of the at least one recipient to identify matching sets of electronic mail message content format settings; and

using the matching sets of electronic mail message content format settings to reformat content of the electronic mail message.

32. A computer program product in a computer readable medium for customizing an electronic mail message based on settings for an intended recipient, comprising:

first instructions for receiving an electronic mail message;

second instructions for retrieving one or more recipient profiles from storage, wherein each recipient profile within the one or more recipient profiles identifies an electronic mail message format for a corresponding recipient;

third instructions for identifying at least one recipient of the electronic mail message;

fourth instructions for identifying at least one electronic mail message format from the one or more recipient profiles for the at least one recipient; and

fifth instructions for reformatting content of the electronic mail message based on the at least one electronic mail message format.

33. The computer program product of claim 32, wherein the at least one recipient is categorized into a recipient group, and wherein the recipient group has electronic mail format settings that are common to all of the recipients in the recipient group.

34. The computer program product of claim 32, wherein the at least one recipient is categorized into a domain name category, and wherein the domain name category has electronic mail format settings that are common to all of the recipients in the domain name category.

35. The computer program product of claim 32, wherein the electronic mail message is directed to a plurality of recipients, and wherein the fifth instructions for reformatting content of the electronic mail message include instructions for identifying a set of compatible electronic

mail message format settings from among the electronic mail message format settings of the plurality of recipients.

36. The computer program product of claim 35, wherein the fifth instructions further include instructions for using a default set of electronic mail message format settings to reformat content of the electronic mail message if a set of compatible electronic mail message format settings cannot be identified from among the electronic mail message format settings of the designated recipients.

37. The computer program product of claim 32, wherein the electronic mail message format settings include at least one of closing information, stationery, or whether to use spell check.

38. The computer program product of claim 32, wherein the electronic mail message is directed to a plurality of recipients, and wherein the fifth instructions for reformatting the electronic mail message includes instructions for replicating the electronic mail message into a different version of the electronic mail message for each of the plurality of recipients based on the electronic mail message format settings for each of the plurality of recipients such that the content of each version of the electronic mail message is the same but the format of the content is specific to the electronic mail message format settings of a corresponding one of the plurality of recipients.

39. The computer program product of claim 38, wherein the electronic mail message is replicated in response to a user entering a command to transmit the electronic mail message.



40. The computer program product of claim 38, wherein the electronic mail message is replicated in response to a command entered by a user, and wherein the user may review the versions of the electronic mail message prior to transmitting them.

41. The computer program product of claim 32, wherein the fifth instructions for reformatting content the electronic mail message include instructions for identifying a common set of electronic mail message format settings for the at least one designated recipient, and wherein the instructions for identifying a common set of electronic mail message format settings include:

instructions for identifying at least one of a group set of electronic mail message content format settings, a domain name category set of electronic mail message content format settings, or an individual set of electronic mail message content format settings for each of the at least one recipient;

instructions for comparing each set of electronic mail message content format settings of each of the at least one recipient to each set of electronic mail message content format settings of each other recipient of the at least one recipient to identify matching sets of electronic mail message content format settings; and

instructions for using the matching sets of electronic mail message content format settings to reformat content of the electronic mail message.

## **EVIDENCE APPENDIX**

There is no evidence to be presented.

## **RELATED PROCEEDINGS APPENDIX**

A Petition to Withdraw Finality of Office Action was filed on May 3, 2006.